

### **REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 2-4 and 6-19 are now present in this application. Claims 2, 11 and 14 are independent. Reconsideration of this application is respectfully requested.

#### **Rejection Under 35 U.S.C. § 102**

Claims 2, 8-11 and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent 711,812 to Armstrong. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherence may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323,

326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

A claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects and the preamble may be limiting, W. E. Hall Co. v. Atlanta Corrugating LLC, 71 USPQ2d 1135 (Fed. Cir. 2004, and Derman v. PC Guardian, 37 USPQ2d 1733 (Fed. Cir. 1995), both cases citing Bell Communications Research, Inc. v. Vitalink Communications Corp., 34 USPQ2d 1816 (Fed. Cir. 1995).

An essential part of the rejection is the decision to deny patentable weight to the claim preamble, which recites “a dryer latch for opening/closing a door of a dryer.”

Applicant respectfully submits that the claimed invention is a dryer latch for opening/closing a dryer and that the claim preamble which recites this feature has to be given patentable weight for a number of reasons.

Firstly, the body of independent claims 2 and 11 recite “a hook adapted to be provided at one side of the door of the dryer” – the dryer that is positively recited in the preamble of the claim.

The Office cites case law, In re Hutchison, 69 USPQ 138, to deny giving patentable weight to the features that use that language, e.g., “a hook” and “a

latch body.” However, the “Hutchinson” case is no longer viable in view of the later case, In re Venezia, 189 USQ 149 (CCPA 1976).

In that case, a number of claims were presented. Claim 31 with emphasis, was representative of the claims on appeal and read, as follows:

31. A splice connector kit having component parts *capable of being assembled* in the field at the terminus of high voltage shielded electrical cables for providing a splice connection between first and second such cables, said cables each having a conductor surrounded by an insulating jacket within a conductive shield wherein a portion of the conductive shield is removed to expose the insulating jacket and a portion of the insulating jacket is removed to expose the conductor at the terminus of the cable, the kit comprising the combination of:

a pair of sleeves of elastomeric material, each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables, each said sleeve having an external surface and a resiliently dilatable internal bore for gripping the insulating jacket to increase the dielectric strength of the creep path along the insulating jacket;

electrical contact means *adapted to be affixed* to the terminus of each exposed conductor for joining the conductors and making an electrical connection therebetween;

a pair of retaining members *adapted to be positioned* respectively between each of said sleeves fitted over the insulating jacket of each said cable and the corresponding terminus of each said cable, said retaining members each having means cooperatively associated therewith for maintaining each said member's position relative to the insulating jacket on each said cable and for precluding axial movement of the sleeve toward the corresponding terminus of each said cable; and

a housing, said housing having an internal bore extending therethrough from end to end, said housing including portions adjacent each end thereof defining said internal bore and being resiliently dilatable *whereby said housing may be slideably positioned* over one of said cables and *then slideably repositioned* over said sleeves, said retaining members, and said contact means *when said sleeves, said retaining members and said contact means are assembled* on said cables as hereinaforesaid, said resiliently dilatable portions of said housing respectively gripping the corresponding external surface of each said sleeve in watertight sealing relationship therewith and said housing having a further portion intermediate its ends defining said internal bore

and forming a sealed chamber enclosing at least said contact means and the exposed portions of said cable conductors *when said housing is in its repositioned location*.

The Court reviewed the disputed claims and in particular the language criticized by the Examiner and the Board, and concluded that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularly, and that they are, therefore, definite as required by the second paragraph of section 112. As the Court viewed these claims, they precisely define a group or "kit" of interrelated parts. The Court continued by stating:

These interrelated parts may or may not be later assembled to form a completed connector. But what may or may not happen in the future is *not* a part of the claimed invention. The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the "kit" of parts itself. For example, paragraph two of claim 31 calls for "a pair of sleeves \* \* \* each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables." Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the "adapted to be affixed" and "adapted to be positioned" limitations in the third and fourth paragraphs of the claim. The last paragraph of claim 31 contains additional language criticized by the board, including "may be slideably positioned," "slideably repositioned," "when said sleeves \* \* \* are assembled," and "when said housing is in its repositioned location." However, this language also defines present structures or attributes of the part of the "kit" identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing

wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims. In re Miller, supra.

Applicant respectfully submits that claim 2, by reciting “a dryer latch for opening/ closing a door of a dryer that includes a front panel having the door installed thereon, comprising” and “a hook adapted to be provided at one side of the door of the dryer wherein a hanging portion is formed at both sides of one end of the hook,” and “a latch body adapted to be provided to one side of the front panel having the door installed thereon wherein the hanging portion is inserted in an insertion hole formed in the latch body,” is positively reciting present structures or attributes of the identified dryer latch, which limits the structure of the dryer latch.

By not giving patentable weight to such positively recited features, the rejection is improper. Moreover, Armstrong has no concept of a dryer latch or dryer door or dryer and, as such, the claimed features are not explicitly or inherently (i.e., necessarily) disclosed by Armstrong.

Additionally, the main body of claims 2 and 11 recite a latch body in four separate clauses, which further defines the structural aspects of the “dryer latch” recited in the claim preamble. For example, the latch body is recited in the main body of the claim in a particular location with respect a front panel

and a door of a dryer to define the structure of the device in terms of specific structural features, including side wall portions, and the way the structural features of the device interact and operate.

In view of this, the Office Action has to give patentable weight to the preambles of claims 2 and 11. In other words, in order to be anticipated, the features of the preambles of claims 2 and 11 must be disclosed.

Applicant also respectfully submits that the Office has given patentable weight to the claim preamble by allowing claim 17, which positively recites the combination of a dryer and the dryer latch of claim 2, and inconsistently does not accord the preamble of claim 2 patentable weight with respect to the remaining claims.

Furthermore, the structural features of the main body of these claims must also be disclosed. This means that, in order to anticipate the claimed invention, a reference has to disclose a number of features including (1) a dryer latch for opening /closing a door of a dryer, (2) a hook adapted to be placed at one side of the door of the dryer, and (3) a latch body adapted to be provided to one side of a front panel having the door installed thereon.

Armstrong discloses none of these features.

Instead, Armstrong merely discloses a holder to connect bows of false ties to a collar stud – see the left hand column, lines 9-10, for example. A collar stud is not a hook adapted to be provided at one side of the door of a

dryer. Nor is a bow tie holder or a false tie holder a door latch for opening/closing the door of a dryer, as claimed.

For these reasons alone, Armstrong does not anticipate independent claims 2 and 11. Nor does Armstrong anticipate claims 8-10, that depend from claim 1, or claim 13, that depends from claim 11.

Furthermore, Applicant respectfully directs the Examiner's attention to the fact situation in the Aforementioned Federal Circuit decision in Derman v. PC Guardian, cited above. There the preamble of the claim recited a "cassette tape chamber" and the body of the claim referred back to that language and used the claim preamble language to provide the necessary definition for a structural limitation that defines the way in which the claimed device operates. Applicant respectfully submits that the claim preambles in this Application also provide a structural limitation that defines the way the device operates. Applicant's claim preambles recite a "dryer latch for opening/closing a door of a dryer. The first clause of claim 1 recites "a hook adapted to be provided at one side of the door of the dryer . . ." It is clear that the hook location of the hook is defined with respect to the door of the dryer, which is recited in the claim preamble. The second clause recites a latch body whose location is recited with respect to a panel of the dryer and the door of the dryer.

Moreover, as explained in the "Derman" decision, not only the claims but also the prosecution history indicated that the invention was designed for use in

a cassette tape deck. Similarly, in this Application, the claimed latch is structured for opening and closing the door of a dryer.

Furthermore, independent claims 2 and 11 positively recite that the dryer includes a front panel having the door installed thereon. This provides proper antecedent basis for the same language recited in the body of those claims and provides additional evidence that the claim preamble has to be given patentable weight.

Accordingly, Applicant respectfully submits that the Office has to give patentable weight to the claim preambles.

Furthermore, Applicant respectfully disagrees with the Office Action's interpretation of Armstrong.

According to the Office Action, Armstrong's elements p,p are "a pair of springs." However, that is not all that is recited in claims 2 and 11. Those claims recite "a pair of springs provided in the rear of the holders, respectively." Inspection of Figs. 2-4, which show springs p of Armstrong, reveals that the springs are not located at the rear of the what are said to be Armstrong's pair of holders e, e. Actually, the springs p are attached to the stud-gripping jaws e, e at about the middle of each of those stud-gripping jaws e, e.

Applicant's springs are located at the rear of its slidable members to push the slidable members. Armstrong's springs do not push the jaws together, so they are not located as recited. Instead, one end of each of Armstrong's springs



is attached to one jaw and the other end of each spring is attached to the other jaw and the springs pull (not push) the jaws together. In this regard, reference is made to the right hand column, lines 69-74, which state that spiral springs p connect the jaws to each other as a means of holding them together with the stud.

The statement that the “rear” is not defined to distinguish over the prior art overlooks the fact that it is a positively recited feature of the claim that is defined in Applicant’s Application in terms of specification description, is shown in the drawings, and was defined enough during the prosecution history to not have been objected to as being unclear until it could not be met by the applied reference. Moreover, because it is a positively recited feature of the claim it must be given patentable weight. In this regard, Applicant respectfully submits that all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Office Action also does not demonstrate that Armstrong discloses “opposing side walls” of the first reception part that are recited as being adjacent to the pair of second reception parts. The Office Action indicates that the first reception part is element “o” that has side wall portions – n, n. However, side wall portions n, n are simply not disclosed as being adjacent to what the Office Action identifies as the pair of second reception parts – d, d. Elements d, d are

located at the top and bottom of the necktie holder whereas the lips “n, n” of element “o” are located in the vertical center of the holder spaced far apart from the location of elements d, d at the top and bottom of the holder.

In rebuttal to this argument, the outstanding office Action says that the term “adjacent” does not specifically define any particular connectivity, distance or further relationship, and that parts d,d are close by or are generally next to parts n,n. Applicant respectfully disagrees and submits that an accepted meaning of “adjacent” is “next to” and that is what is meant by “adjacent.”

Additionally, the Office Action states that the protrusion of claim 2 corresponds to elements j,j of Armstrong (page 2, body of rejection under 35 USC §102). Applicant respectfully submits that this position is inconsistent with the Examiner’s analysis of Armstrong ‘812.

The Office Action asserts that the claimed pair of holders that are linearly slidable in the latch body to directly hold the hanging portion are elements e,e, which Armstrong ‘812 discloses are stud-gripping jaws (left column, lines 39-47). The Office Action also asserts that elements “j,j” of Armstrong ‘812, which are the flanged outer ends of stud-gripping jaws e, constitute the “protrusion” recites as being formed on one side of each of the holders to be held against sliding in the latch body by one of the side wall portions of the first reception part. However, Armstrong ‘812 does not disclose that flanged outer ends j are formed on one side of each of the holders to be held against sliding in the latch body. Instead, that

function is attributed to lip “n,” which extends from face plate “o.” Accordingly, the Office’s interpretation of Armstrong ‘812 is inconsistent and cannot properly serve as a proper basis to anticipate independent claim 2.

Moreover, because claims 8-10 depend from claim 2, Armstrong fails to anticipate claims 8-10 as well as claim 2.

Furthermore, with respect to claim 10, the hole for each spring in Armstrong is not located “in the rear of the holder” as recited. As explained above, the holes for Armstrong’s springs are located in the middle of its jaws.

Moreover, with respect to claim 11, Applicant respectfully submits that Armstrong has no element that can be reasonably construed as a “latch cap”, which is defined in claim 11 as “covering first and second reception parts to prevent separation of the holders and the springs from the latch body,” especially if the Office Action relies on elements “a” and “o” as the claimed “latch body.” The Office cannot have it both ways, i.e., to construe the combination of elements “a” and “o” to be the latch body in the rejection and then say that just one of those elements is a separately recited latch cap in the same claim. This is a contradiction.

Furthermore, it is inconsistent for the Office to interpret Armstrong’s element “o” as a “first reception part” and Armstrong’s element “d” as a “second reception part” regarding claim 2, and to interpret the left/right sides of Armstrong’s element “a” as “reception parts.”

Additionally, with respect to claim 13, because Armstrong does not disclose a separately recited latch cap element, the Armstrong cannot disclose a positively recited guide protrusion extending from the bottom of a non-existent latch cap. Moreover, parts n,n are already relied on in the rejection as “side wall portions” of the first reception part. The Office Action does not explain, and Applicant does not understand how what are characterized as side wall portions of the first reception part can also constitute separately recited latch cap protrusions.

Also, elements “n, n” do not guide anything. Perhaps that is why the Office Action indicates that this positively recited feature of “guide protrusions . . . to guide movement of the holders,” is being given no patentable weight. However, it is completely improper for the Office Action to fail to give patentable weight to the positively recited, clear and definite language of “guide protrusions protrude from a bottom of the latch cap to guide movement of the holders, respectively.” Moreover, as noted above, this failure to give patentable weight to every word in the claim is improper.

In response to this argument, the Office Action indicates that elements “n,n” of Armstrong define the extent of movement of the holders and potentially prevent gross displacement of the holders. Applicant respectfully submits that, at best, Armstrong’s teaches that lips “n,n” “prevent escape of the jaws” (right

hand column, lines 61-66), and that stopping movement of a holder is not the same as guiding (directing) the movement of a holder.

Reconsideration and withdrawal of this rejection of claims 2, 8-11 and 13 is respectfully requested.

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Armstrong in view of U.S. Patent 2,629,156 to Kamens. This rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,

664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action asserts that it would have been an obvious design choice or engineering expedient for one of ordinary skill in the art to provide a triangular profile as shown by Kamens to improve the guidance of "c" as it is being inserted from an off-center axis. The Office Action also states that the proposed modification of Armstrong would not otherwise affect the function of the device.

Applicant respectfully disagrees.

Initially, Applicant respectfully notes that the claimed invention is not anticipated by Armstrong for reasons stated above, and that Kamens fails to remedy the aforementioned deficiencies on Armstrong. Thus, even if it were proper to modify Armstrong, as suggested (which it is not, at least for reasons discussed below), the suggested modified version of Armstrong would not render the claimed invention obvious.

Furthermore, Applicant respectfully submits that the significant differences between these two references teach away from combining these references as suggested in the rejection.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that

the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), cert. denied, 469 U.S. 851 (1984); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); In re Caldwell, 319 F.2d 254, 256, 138 USPQ 243, 245 (CCPA 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant). See, In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994).

Armstrong is directed to a holder to secure bow ties or false ties to a collar stud. There is only one example of a collar stud shown in Armstrong and it has a rounded portion facing and touching the tie and inserted into and through the holder. Applicant respectfully submits that the head is rounded so that it will not damage the tie it comes into contact with or injure or startle the wearer of the tie and of the shirt collar to which the tie is held.

Kamens, on the other hand, is directed to a necklace catch that connects a small, thin male member that fits in a "central longitudinal compartment 23" of housing 20. The male member has a V- shape that is received by a v-shaped element 30 inside of the central longitudinal compartment 23 as part of the clasp.



The Office Action fails to provide objective factual evidence that one of ordinary skill in the art would be motivated to look to Kamens necklace clasp structure to modify a collar stud because of these significant differences between the two devices.

Moreover, Applicant respectfully submits that one of ordinary skill in the art would have no incentive to modify Armstrong's rounded collar stud portion "c" to make it into a sharp v-shaped member because such a modification would be likely to ruin the bow ties and false ties it would press against by puncturing and/or tearing them, and would constitute a hazard to a user's fingers when handling such an inherently sharp object.

Furthermore, alleging that something is an obvious design choice or engineering expedient fails to take the invention as a whole into consideration and fails to provide objective factual evidence of motivation. The Office Action relies upon these assertions as establishing a *per se* rule that any modification of a reference is obvious simply by stating that the modification is an obvious design choice or engineering expedient. As stated by the Federal Circuit in In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to make the suggested modification of Armstrong in view of

Kamens and fails to make out a *prima facie* case of obviousness of claims 6 and 7.

In response to these arguments, the Office states that Applicants' arguments concerning the proposed modification of Armstrong in view of Kamens is speculation overlooks the fact that the Office has the burden of making out a *prima facie* case of proper motivation and clearly has not provided any objective factual evidence in support of its conclusion of proper motivation. Unless and until the Office makes out a *prima facie* case of obviousness, which includes a showing of proper motivation to modify the base references, as suggested, the burden does not shift to Applicant to rebut the non-existent *prima facie* case. So, attacking Applicant's showing has no merit here, where the burden has not shifted to Applicant. Furthermore, Applicant's arguments in this regard are fully supported by the explicit disclosure of both applied references and, as such, are supported by objective factual evidence of record.

Reconsideration and withdrawal of this rejection of claims 6 and 7 are respectfully requested.

Allowed and Allowable Subject Matter

Applicant acknowledges with appreciation the allowance of claims 14 and 19.

Applicant also acknowledges with appreciation the indication of allowable subject matter in claims 3, 4, 12 and 15-18, and that those claims would be allowable if rewritten in independent form.

Applicant has not re-written claims 3, 4, 12 and 15-18 in independent form, however, because of Applicant's belief that claim 2, from which claims 3, 4, and 15-17 depend, and claim 11, from which claims 12 and 18 depend, are allowable, for reasons stated above.

#### Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

#### CONCLUSION

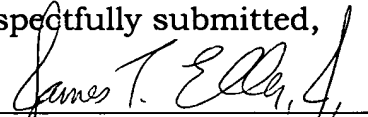
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant respectfully requests that the Examiner withdraw the finality of the outstanding Office Action, reconsider all presently outstanding objections and rejections and that those objections and rejections be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Dated: **JUNE 2, 2006**

Respectfully submitted,

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